

Application SN: 10/812,649
Amendment Dated: January 11, 2005
Reply to Office Action of: August 11, 2004

REMARKS

The Office Action has been reviewed. The requirement regarding use of trademarks, Paragraph 1, is noted. It is believed that terms such as Photomatte®, Hewlett Packard® and others have been properly capitalized to indicate their trademark or trade name status. Upon the finding of allowable subject matter, the application will be reviewed and any appropriate correction will be made, as well as correction of any other minor grammatical, typographical errors that may have occurred.

DECLARATION OF MR. ROSS

The Declaration of Mr. Ross accompanies this Response. Mr. Ross is the founder of Clear Focus Imaging, one of the largest manufacturers of one-way window graphics and is familiar with the technology in this area.

Rule 132 Affidavits or Declarations are to be considered on the issue of non-obviousness, particularly in two areas: (1) unexpected properties and advantages and (2) commercial success. Although the Declaration of Mr. Ross was prepared in response to an Office Action dated May 29, 2003, in the parent application, the statements are applicable to the present Office Action as the issues are substantially the same.

Mr. Ross states the Applicant's invention solves the problem of proper adherence of printing ink supplies by ink jet printers to plastic films due to the poor absorption characteristic of the film. Mr. Ross states that a product termed "Jet Vue," manufactured by his company, incorporates the teachings of both the Applicant's issued patent as well

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as the method of the present application. The Jet Vue product provides improved clarity and image durability due substantially to the method of application.

In addition to setting forth advantages, the Declaration also establishes secondary considerations of patentability, namely commercial success and a long felt need.

5 Mr. Ross has extensive knowledge and expertise in the field of one-way vision window graphics.

Mr. Ross also examines the references in his Declaration and concludes that the referenced patents to Shields, Andriash and Mimura, et al deal with different problems and that the claims are not an obvious variation of the references cited.

10 **CLAIM REJECTION 35 U.S.C. §112**

Turning now to Paragraphs 2 and 3, Claims 11 have been rejected under 35 U.S.C. §112. The Examiner states that Claim 11 is rejected because the Specification does not reasonably provide enablement for second surface with a dark colored surface.

15 Claim 11 is a dependent claim depending from Claim 8. Claim 8 specifies that the substrate has first and second surfaces, one being light colored and the second surface being dark colored. Claim 11 specifies applying an adhesive to the second surface. Reference is made to the Specification, Page 4, Lines 5 through 8, where substrates 12 is described as being transparent or opaque. The Specification further suggests that the front surface may be flood coated with white or light reflecting screen printing or the like. It is
20 submitted that the same technique, as well as others such as other well known coating

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methods for applying inks or dyes, may be used to create a dark surface. Such techniques are well known to those in the printing arts. Further, films having various colored surfaces are readily available from fabricators.

5 The enablement requirement 35 U.S.C. §112 requires the written description teach those in the art how to make and use the invention as broadly as is claimed without undue experimentation. Since the application suggests various coating techniques for applying colorization to a surface, it would be within the skill of the art to flood coat a surface of the film with a dark or light absorbing coating by screen printing. The only change necessary would be the color.

10 Page 1, lines 11 and 12 acknowledge that most see through films are coated on one side with a pigment.

The disclosure is directed to those skilled in the art to which the invention pertains and thus need not include what is common and known in the art. *In re Howarth*, 210 USPQ 689 (CCPH 1981)

15 The fact that one-way panels having a dark surface are know in the art is recognized in Andriash, U.S. Patent No. 5,679,435 at column 2, lines 66 continuing to column 3, line 2.

Reference is also made to the accompanying Declaration of Mr. Ross stating that it is within the skill of an artisan to apply pigments and coatings to substrates.